REMARKS

This response is intended as a full and complete response to the final Office Action mailed January 11, 2005. In the Office Action, the Examiner notes that claims 1-78 are pending and rejected. By this response, the Applicant has amended claims 1, 22 and 43, cancelled claims 64-78, and added new claims 79-81. The amendments to the claims and the newly added claims are fully supported by the Specification. For example, the amendments and newly added claims are supported at least by pages 70-80 of the Specification. Thus, no new matter has been introduced, and the Examiner is respectfully requested to enter the amendments and new claims.

In view of the following discussion, the Applicant submits that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Thus, the Applicant believes that all of these claims are now in allowable form.

The Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to the Applicant's subject matter recited in the pending claims. Further, the Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response including amendments.

REJECTIONS

35 U.S.C. §102

Claims 1-5, 8, 9, 12-14, 16, 19-26, 29, 30, 33-35, 37, 40-47, 50, 51, 54-56, 58, 61-65, 67-70, 72-75, and 75-78

The Examiner has rejected claims 1-5, 8, 9, 12-14, 16, 19-26, 29, 30, 33-35, 37, 40-47, 50, 51, 54-56, 58, 61-65, 67-70, 72-75 and 75-78 under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent 6,553,178-B2 to Abecassis. The Applicant respectfully traverses the rejection.

Claims 1, 22 and 43

Applicant's independent claim 1 recites (emphasis added below):

> "1. A method for automatically pausing a video program in response to an occurrence of an event, comprising:

receiving a video program and outputting the video program for presentation on a display device;

detecting occurrence of an incoming request for communications during the video program, the request coming from other than a viewer of the video program;

pausing the video program in response to the detection of the occurrence of the incoming request for communications; and

outputting a signal for displaying an indication of the occurrence of the incoming request for communications."

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). The Abecassis reference fails to disclose each and every element of the claimed invention, as arranged in claim 1.

Specifically, the Abecassis reference fails to teach or suggest "pausing the video program in response to the detection of the occurrence of the incoming request for communications" as recited in the amended claim 1.

The Abecassis reference discloses an advertisement subsidized video on demand system in which, in relevant part, the user of the system may accept a communication during the use of the system and, in response to the acceptance of such communication, cause a video server transmission to be paused. Specifically, the Abecassis reference (see, e.g., FIG. 13, reference 1311 and column 52, line 18+) discloses an acceptance procedure that is invoked in response to a received communication, wherein a user must affirm an acceptance of the received communication within a prescribed period of time, and only after the acceptance is there any pausing of content.

By contrast, the claimed invention pauses a video program in response to the detection of an incoming request for communications. Such a request for communications, of which the detection thereof pauses the video program, is clearly described in the Specification, for example on pages 70 and 71. Examples of such a request given in the Specification include, inter alia, detection of an incoming telephone call and detection of an incoming email message.

Thus, since the claimed step of "pausing the video program in response to the detection of the occurrence of the incoming request for communications" is not taught by the Abecassis reference, the invention of claim 1 is patentable under 35 U.S.C. §102 over Abecassis. Moreover, it is noted that independent claims 22 and 43 include a substantially similar limitation to that discussed above with respect to claim 1. As such, the Applicant submits that amended independent claims 1, 22, and 43 are not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Furthermore, the dependent claims including claims 2-5, 8, 9, 12-14, 16, 19-21, 23-26, 29, 30, 33-35, 37, 40-42, 44-47, 50, 51, 54-56, 58, 61-63 depend, either directly or indirectly, from independent claims 1, 22, and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, Applicant submits that these dependent claims are also not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. The remaining rejected claims have been cancelled. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103

Claims 6, 7, 27, 28, 48 and 49

The Examiner has rejected claims 6, 7, 27, 28, 48 and 49 as being unpatentable over U.S. Patent 6,553,178-B2 to Abecassis in view of the MSN Messenger Service (hereinafter "MSN"). The Applicant respectfully traverses the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Abecassis and MSN references alone or in combination fail to teach or suggest the Applicant's invention as a whole.

As discussed above, Abecassis does not teach or suggest "pausing the video program in response to the detection of the occurrence of the incoming request for communications" as recited in the amended claims 1, 22 and 43.

The MSN reference fails to bridge the substantial gap between the Abecassis reference and the applicants invention as recited in claims 1, 22 and 43. The MSN reference discloses that a user can "[b]e automatically notified when you receive new messages in your Hotmail e-mail account" by the MSN Messenger Service. However, the MSN reference does not teach pausing a video program in response to the detection of the new e-mail message. Thus, the Abecassis reference and the MSN reference, either singly or in any optimal combination, fail to disclose or suggest at least the claim step of pausing the video program in response to the detection of the occurrence of the incoming request for communications.

As such, the Applicant submits that independent claims 1, 22 and 43 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 6, 7, 27, 28, 48 and 49 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 10-11, 31, 32, 52 and 53

The Examiner has rejected claims 10-11, 31, 32, 52 and 53 as being unpatentable over Abecassis in view of U.S. Patent 6,349,410 to Lortz. The Applicant respectfully traverses the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). The Abecassis and Lortz references alone or in combination fail to teach or suggest the Applicant's invention as a whole.

As discussed above, Abecassis does not teach or suggest "pausing the video program in response to the detection of the occurrence of the incoming request for communications" as recited in the amended claims 1, 22 and 43.

The Lortz reference does not bridge the substantial gap between the Abecassis reference and the Applicant's invention. Specifically, the Lortz reference discloses an integrating broadcast television pause and web browsing arrangement. Specifically, the Lortz arrangement addresses the coordination of displaying incoming signal stream including URLs and web imagery associated with the URLs. For example, as noted in column 3, final full paragraph:

> "When the user wants to access web content reference by the most recent URL, the user in one embodiment presses the forward button 26 on their remote control. At block 42, the set top device receives the forward signal from the remote control. This causes the set top device to pause or display of the signal stream currently being received at block 44, while continuing to save the incoming signal stream on the storage device. The set top device then obtains the web content for the most recently stored URL from the appropriate web server at block 46."

That is, the user affirmatively decides to pause the signal stream and retrieve a web page, such affirmation being indicated by the pressing of a forward button 26 on the remote control. Thus, the Abecassis reference and the Lortz reference, either singly or in any optimal combination, fail to disclose or suggest at least the claim step of pausing the video program in response to the detection of the occurrence of the incoming request for communications.

As such, the Applicant submits that independent claims 1, 22 and 43 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 10-11, 31, 32, 52 and 53 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 15, 36 and 57

The Examiner has rejected claims 15, 36 and 57 as being unpatentable over Abecassis in view of U.S. Patent 6,543,053 to Li. The Applicant respectfully traverses the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). The Abecassis and Li references alone or in combination fail to teach or suggest the Applicant's invention as a whole.

As discussed above, Abecassis does not teach or suggest "pausing the video program in response to the detection of the occurrence of the incoming request for communications" as recited in the amended claims 1, 22 and 43.

The Li reference does not bridge the substantial gap between the Abecassis reference and the Applicant's invention. The Li reference discloses a data distribution system with video-on-demand services including VCR-like functions such as a pause function. However, the Li reference does not teach pausing a video program in response to the detection of an incoming request for communications. Thus, the Abecassis reference and the Li reference, either singly or in any optimal combination, fail to disclose or suggest at least the claim step of pausing the video program in response to the detection of the occurrence of the incoming request for communications.

As such, the Applicant submits that independent claims 1, 22 and 43 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 15, 36 and 57 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 17, 38 and 59

The Examiner has rejected claims 17, 38 and 59 as being unpatentable over Abecassis in view of U.S. Patent 6,052,508 to Mincy. The Applicant respectfully traverses the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). The Abecassis and Mincy references alone or in combination fail to teach or suggest the Applicant's invention as a whole.

As discussed above, Abecassis does not teach or suggest "pausing the video program in response to the detection of the occurrence of the incoming request for communications" as recited in the amended claims 1, 22 and 43.

The Mincy reference does not bridge the substantial gap between the Abecassis reference and the Applicant's invention. The Mincy reference discloses editing interfaces for a moving picture recording device, the interfaces including "[t]he 'FRAME' keys, denoted as '<' and '>', [which] step a display frame back or ahead by one" (column 19, lines 47-48). However, the Mincy reference does not teach pausing a video program in response to the detection of an incoming request for communications. Thus, the Abecassis reference and the Mincy reference, either singly or in any optimal combination, fail to disclose or suggest at least the claim step of pausing the video program in response to the detection of the occurrence of the incoming request for communications.

As such, the Applicant submits that independent claims 1, 22 and 43 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 17, 38 and 59 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 18, 39 and 60

The Examiner has rejected claims 18, 39 and 60 as being unpatentable over Abecassis in view of the ReplayTV manual (hereinafter "ReplayTV"). The Applicant respectfully traverses the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). The Abecassis and ReplayTV references alone or in combination fail to teach or suggest the Applicant's invention as a whole.

As discussed above, Abecassis does not teach or suggest "pausing the video program in response to the detection of the occurrence of the incoming request for communications" as recited in the amended claims 1, 22 and 43.

The ReplayTV reference does not bridge the substantial gap between the Abecassis reference and the Applicant's invention. The ReplayTV reference discloses a 'Return to Live' button which "[r]eturns your ReplayTV to live television broadcasts after using PAUSE, REWIND, FAST FORWARD, or STOP" buttons. However, the ReplayTV reference does not teach pausing a video program in response to the detection of an incoming request for communications. Thus, the Abecassis reference and the ReplayTV reference, either singly or in any optimal combination, fail to disclose or suggest at least the claim step of pausing the video program in response to the detection of the occurrence of the incoming request for communications.

As such, the Applicant submits that independent claims 1, 22 and 43 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 18, 39 and 60 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 66, 71 and 76

The Examiner has rejected claims 66, 71 and 76 as being unpatentable over Abecassis in view of U.S. Patent 5,699,107 to Lawler. However, claims 66, 71 and 76 have been cancelled, thus rendering the rejection moot. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

NEWLY ADDED CLAIMS

Newly added claims 79-81 are believed to be patentable because they depend from claims 1, 22 and 43 which are believed to be patentable as discussed above.

CONCLUSION

Thus, Applicant submits that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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